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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/891,471	06/27/2001	Masakazu Ogasawara	041514-5130	1389

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MORGAN LEWIS & BOCKIUS LLP
1111 PENNSYLVANIA AVENUE NW
WASHINGTON, DC 20004

EXAMINER

PSITOS, ARISTOTELIS M

ART UNIT	PAPER NUMBER
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2653

DATE MAILED: 09/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	09/891,471		OGASAWARA ET AL.	
	Examiner		Art Unit	
	Aristotelis M. Psitos		2653	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 April 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 7 and 8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 7, 8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

24

Art Unit: 2653

DETAILED ACTION

Applicants' response of 4/14/05 has been considered with the following results.

Information Disclosure Statement

The Ids filed on 7/904 & 10/26/04 have been reviewed and made of record.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

1. Claims 1 and 7 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a range of 10-50 micrometers squared does not reasonably provide enablement for the newly introduced range of less than 50 micrometers squared, i.e., there is a lower limit as disclosed which is not encompassed by the newly introduced (amended) claims. It is noted that the proper range is recited in claim 8.

As far as the claims are interpreted, the following rejections are made.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Claims 1,7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamakawa et al further considered with Ichimura et al and both further considered with EP 0814465.

The references to Yamakawa et al and Ichimura et al are relied upon for the reasons of record. The newly cited EP document, provided by applicants, relate to equations known to those of ordinary skill in the art relating ct (cross talk) with various parameters – see page 4, starting at line 2 to page8 line 46. With respect to claim 7, the examiner concludes that such a desired result (3%) or lower distortion is yielded from the above noted dimensions for the normalized detector.

Art Unit: 2653

It would have been obvious to modify the base system of Yamakawa et al and Ichimura et al with the above parameters disclosed in the EP document and derive the recited formula.

Response to Arguments

Applicant's arguments with respect to claims 1 and 7 have been considered but are not considered persuasive.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Furthermore, applicants argue that modification of the NA of the base reference would be inconsistent with that of the range disclosed in Yamakawa due in part to applicants' decision of narrowing the range predicated upon

“ the basis of the focus-servo capture range and interlayer crosstalk in the pickup device with the optics having a NA of 0.85 or more”.

In response to this, no such requirement is found in the claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Furthermore, the examiner has provided reasoning as to why such a variation in NA would flow from the references.

Again, the examiner is not persuaded. The passages noted by applicants and reviewed by the examiner lead the examiner to conclude the sizes mentioned,(see for instance at column 18, lines 4-21: 16, 10, 4 and 2 μm is the measurement along one axis, either the x or y axis, and that in order to yield applicants' claimed squared parameters (μm) , one would multiple two dimensions.. That is the examiner interprets the detectors as squares having both their x and y axis the same value – such as 16, 10, 4 or 2 or 6, or 8 μm would yield values appropriately – 256, 100, 16, 4, 36, 64 (μm). Since these values overlap the claimed values and in keeping with *In re Peterson* (cited in previous OA), this argument is not persuasive.

Claim Rejections - 35 USC § 103

3. Claims 1,7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakano et al further considered with either by Narahara et al or Ichimura et al and all further considered with the EP 0814465.

The following analysis is made:

Claim 1

Nakano et al

A pickup device of an apparatus for recording or reproducing information, by irradiation of a light beam, to and from a multi-layered recording medium having a plurality of recording layers laminated through spacer layers, the device comprising:

see the abstract, and
summary of the invention
figure 1

an illumination optical system including an objective lens for focusing a light beam onto any of said recording layers of said multi-layered recording medium; and

in fig. 1 element 43
is the objective lens,
the medium is multi-layered

a detecting optical system including a photodetector for receiving and photo electrically converting reflection light from said recording layers of said multi-layered recording medium through said objective lens;

in the above figure, the
detector is element 61
see figure 3 as well.

wherein said photodetector has a normalized detector size: (B/λ) of a size of 50 μm or lower, and

see col. 6 starting at
line 6

wherein the normalized detector size (B/λ) is given

see EP document

Art Unit: 2653

by an equation of:

$$(B/\beta) = L / (f_o / f_{ob})$$

wherein L denotes a size of one side of the photodetector,

f_o denotes a focal distance of the detecting optical system and

f_{ob} denotes a focal distance of the objective lens,

wherein said objective lens has a numerical aperture

NA value see.

of 0.85 or greater.

refs. to

Narahara et al or Ichimura et al.

In the above Nakano et al system, the ability of having plural recording layered medium appropriately focused and subsequently detected is discussed – see col. 5 starting at line 18.

Furthermore, as also found in col. 6 lines 6 plus, the ability of sizing the detector accordingly is discussed – including the claimed “normalization” thereof.

It is the EP document to Takahashi describes the above claimed formulas as part and parcel of the subject matter known to those in this environment.

Finally, the ability of altering the NA, i.e., increasing such so as to decrease the spot size and thereby permit even denser recording capabilities is taught/discussed in the article by Narahara et al or the previously cited patent to Ichimura et al teach such a NA value in this environment for the desired increased disc capacity.

It would have been obvious to modify the base system of Nakano et al with the above teaching from either of these secondary references, motivation is as taught to increase the disc capacity.

With respect to the parameters discussed in the formula, again the EP document is relied upon for the reasons stated above.

It would have been obvious to modify the base system of Nakano et al/Narahara or Ichimura et al with the above mathematical parameters/relationships discussed in the EP document and derive the formula parameters recited. The examiner concludes that such is an exercise in mathematics, and obvious to one of ordinary skill in the art.

Art Unit: 2653

Response to Arguments

Applicant's arguments with respect to these claims have been considered but are moot in view of the new ground(s) of rejection. With respect to the dimensional limitations, the claimed range overlaps the range disclosed in the base reference. Since these values overlap the claimed values and in keeping with *In re Peterson* (cited in previous OA), the claimed limitations are considered obvious.

Conclusion

2. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aristotelis M. Psitos whose telephone number is (571) 272-7594. The examiner can normally be reached on M-Thursday 8 - 4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William R. Korzuch can be reached on (571) 272-7589. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2653

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Aristotelis M Psitos
Primary Examiner
Art Unit 2653

A handwritten signature in black ink, appearing to read 'AMP', with a long, sweeping horizontal line extending to the right.

AMP